

This Page Is Inserted by IFW Operations  
and is not a part of the Official Record

## **BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,  
please do not report the images to the  
Image Problems Mailbox.**



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/192,579 11/17/98 MENDOZZI

F 960-34

EXAMINER

HM22/0927

NIXON AND VANDEHYDE  
1100 NORTH GLEBE ROAD  
8TH FLOOR  
ARLINGTON VA 22201

SWARTZ, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

09/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/192,579

Applicant(s)  
Menozzi et al

Examiner  
Rodney P. Swartz, Ph.D.

Art Unit  
1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 8February1999, 29January2001.

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 30-35 and 56-81 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 30-35 and 56-81 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☒ Other: copy of Oath/Declaration

Art Unit: 1645

### **DETAILED ACTION**

1. Applicants' Preliminary Amendment is acknowledged. Claim 1-29 have been canceled without prejudice.

New Claims 30-55 have been added. However, new claims 30-55 are objected to under 37 CFR §1.52(a) and (d), requiring that any amendments must be in the English except when accompanied with an English translation, a statement that the translation is accurate, and the appropriate fees.

2. Applicants' Second Preliminary Amendment, received 8February1999, paper#9, is acknowledged. Claims 36-55 have been canceled without prejudice. New Claims 56-81 have been added.

3. Applicants' Response to Notice to Comply, received 29January2001, paper#15, is acknowledged. The sequence listing has been entered.

4. Claims 30-35 and 56-81 are pending.

### **Oath/Declaration**

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the facsimile copy of contains many indistinct and missing sections (see attached copy).

Art Unit: 1645

**Priority**

6. Acknowledgment is made of applicant's claim for foreign priority based on application 96/06168 filed in France on 17May1996. It is noted, however, that applicant has not filed a certified English translation of the application as delineated in 35 U.S.C. 119(b). Until a certified English translation of the application is submitted, the priority date is that of the instant application.

**Election/Restriction**

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 30-35, 56-70, drawn to polypeptides, classified in class 424, subclass 248.1.
  - II. Claims 71-78, drawn to DNA, vector, host cell, classified in class 536, subclass 23.7.
  - III. Claim 79, drawn to use of polypeptide to make a drug, classified in class 424, subclass 181.1.
  - IV. Claims 80-81, drawn to method of inhibiting mycobacterial adhesion, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are drawn to structurally and functionally distinct molecules, Invention I is drawn to amino acids and Invention II is drawn to nucleic acids.

Art Unit: 1645

Inventions I and III-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Invention I can be used to immunize a host against infection with mycobacteria.

Inventions II and III-IV are drawn to structurally and functionally distinct molecules, Invention II is drawn to nucleic acids and Inventions III-IV are drawn to amino acids.

Inventions III and IV are drawn to patentably distinct methods using different reagents and having different outcomes.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and because while the searches may overlap, the searches are not coextensive, restriction for examination purposes as indicated is proper.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

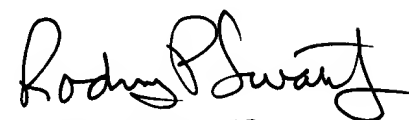
Art Unit: 1645

application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.



RODNEY P. SWARTZ, PH.D.  
PRIMARY EXAMINER  
Art Unit 1645

September 27, 2001

960-34  
B3168AAB-MR

63  
1.1  
OF.  
EY  
PATL  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ann 3 13. de l'hye P.C. (12/85)

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name, and I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

# IDENTIFICATION AND CLONING OF A MYCOBACTERIAL ANTIGEN CORRESPONDING TO A HEPARIN-BINDING HAEMAGGLUTININ

the specification of which (check applicable box(es)):

☐ is attached hereto  
☒ was filed on November 17, 1998 as U.S. Application Serial No. 09/102,579 (Atty Dkt. No. 050-34)  
☒ was filed as PCT International application No. PCT/FR97/00886 on 20 May 1997  
 and (if applicable to U.S. or PCT application) was amended on \_\_\_\_\_

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with 37 C.F.R. 1.56. I hereby claim foreign priority benefits under 35 U.S.C. 119.385 of a foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed or, if no priority is claimed, before the filing date of this application.

Priority Foreign Application(s):  
 Application Number  
86/06168

Day/Month/Year Filed  
17 May 1996

I hereby claim the benefit under 35 U.S.C. 119.385 of all prior United States and PCT International application(s) listed above or below and, insofar as the subject matter of each of the claims of this application is not disclosed in such prior applications in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose material information as defined in 37 C.F.R. 1.56 which occurred between the filing date of the prior applications and the national or PCT international filing date of this application:

Prior U.S./PCT Application(s):  
 Application Serial No.  
PCT/FR97/00886

Day/Month/Year Filed  
20 May 1997

Status: patented  
 pending, abandoned

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon. And I hereby appoint NIXON & VANDERHYE P.C., 1100 North Glebe Rd., 8th Floor, Arlington, VA 22201-4714, telephone number (703) 816-4000 (to whom all communications are to be directed), and the following attorneys thereof (of the same address) individually and collectively my attorneys to prosecute this application and to transact all business in connection with the Patent and Trademark Office connected therewith and with the resulting patent: Arthur R. Crawford, 2017, Larry S. Nixon, 26640; Robert J. Vanderhye, 27076; James T. Hosmer, 30184; Robert W. Farris, 31352; Richard G. Busha, 22770; Mark E. J. 2348; Michael J. Keenan, 321; ya H. Davidsen, 30251; Stanley C. Spooner, 27393; Leonard C. Milcha, 29009; John H. 30481; John R. Last, 149; H. Warren Burnam, Jr., 29365; Thomas E. Byrne, 32205; Mary J. V. 37; M. Kagen, 38176; William J. 31260; Robert A. Molan, 29834; B. J. Sadoff, 38663; James D. Ben, 347; C. 34775; C. L. Jach, 41090.

1. Inventor's Signature: Franco MENOZZI Italian  
 Inventor: (first) (last) (citizenship)  
 Residence: (city) Mons-Hyon (state/country) Belgium  
 Post Office Address: 28, rue des Canadiens, Mons-Hyon, Belgium  
 (Zip Code) B-7022

2. Inventor's Signature: Camille LOCHT Belgium  
 Inventor: (first) (last) (citizenship)  
 Residence: (city) Wannehain (state/country) France  
 Post Office Address: 14, rue du Vert Pré, Wannehain, France  
 (Zip Code) F-59830

Date: March 17/1999

FOR ADDITIONAL INVENTORS, check box ☐ and attach sheet with same information and signature and date for each.